

### REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed July 11, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

#### **I. Claim Objections**

Claims 5, 6, 8, and 11 have been objected to for having a "double recitation problem." Claims 5, 6, 8, and 11 are canceled without prejudice, waiver, or disclaimer, and therefore, the objection to these claims are rendered moot. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these canceled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the canceled subject matter to the public.

#### **II. Claim Rejections - 35 U.S.C. § 102(b)**

Claims 1, 5-6, 8-11, 29-32, and 38-39 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Takeuchi* (U.S. Pat. No. 5,860,644). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the *Takeuchi* reference. Applicant discusses the *Takeuchi* reference and Applicant's claims in the following.

Applicant's claim 1, for example, provides as follows (emphasis added):

An imaging device, comprising:

a main unit that includes a print mechanism and a media input tray; and

a physically separate auxiliary unit that is positioned below the main unit, couples with the same in stacked configuration, and physically supports the main unit, the auxiliary unit including an integral document finishing mechanism and a further media input tray,

*wherein the document finishing mechanism is accessible from an environment outside the imaging device through a slot provided in an exterior of the auxiliary unit such that media is fed through the slot into the document finishing mechanism from outside the auxiliary unit, wherein the auxiliary unit has a footprint that is substantially the same as a footprint of the main unit.*

*Takeuchi* discloses a base B, on which a printer P is supported. See col. 2, lines 29-31. The stacker S and the feeder F are adapted to be enclosed in the base B below the printer P. See col. 2, lines 65-66. With regard to one aspect of pending claim 1, the main unit of *Takeuchi* does not include a media input tray.

Further, Applicant respectfully submits that none of the cited art references appears to disclose a configuration, in which an auxiliary unit contains a document finishing mechanism that is accessible from an environment outside the imaging device through a slot provided in the auxiliary unit such that media is fed through the slot into the document finishing mechanism from outside the auxiliary unit. For example, in reviewing *Takeuchi*, a sheet feeder device F is disclosed for feeding paper into a printer unit P. After the paper is printed by the printer unit P, the paper may be diverted to a sorter device M or stacker device S. It is noted that sheet feeder device F does not perform any finishing functions. Therefore, it does not meet the claimed limitations.

Also, a sheet stacker device S is disclosed in FIG. 1 of *Takeuchi*. However, the sheet stacker device S is fed printed paper from an internal feed roll SR. Accordingly, sheet stacker device S does not contain a slot that is accessible from an environment outside the imaging device or a mechanism for feeding media into the sheet stacker device S from outside the imaging device. Likewise, sorter device M is also shown to be fed internally from the printer unit P. See FIG. 1. Further, as shown in FIG. 1, a slot is not visible on the exterior of the housing sections H1 and H2 that is used to feed paper into stacker or sorter devices S, M.

Hence, *Takeuchi* fails to teach or suggest at least “wherein the document finishing mechanism is accessible from an environment outside the imaging device through a slot provided in an exterior of the auxiliary unit such that media is fed through the slot into the document finishing mechanism from outside the auxiliary unit,” as recited in claim 1. (Emphasis added).

For at least the foregoing reason, claim 1 is allowable over *Takeuchi*, as are claims 9-10 that depend from claim 1.

Regarding claim 30, it provides as follows (emphasis added):

An auxiliary unit for an imaging device, wherein the auxiliary unit is locatable physically separate from a main unit of the imaging device and is couplable in a stacked configuration with the main unit including a print mechanism and a media input tray, so that the auxiliary unit is positioned below the main unit, wherein the auxiliary unit comprises:

*an integral document finishing mechanism accessible from an environment outside the imaging device through a slot provided in the exterior of the auxiliary unit such that printed media is fed through the slot into the document finishing mechanism from outside the auxiliary unit; and*

a further media input tray; wherein the auxiliary unit has a footprint that is substantially the same as the footprint of the main unit.

For at least the reasons as stated above with regard to claim 1, *Takeuchi* fails to teach or suggest at least "an integral document finishing mechanism accessible from an environment outside the imaging device through a slot provided in the exterior of the auxiliary unit such that printed media is fed through the slot into the document finishing mechanism from outside the auxiliary unit, as recited in claim 30. (Emphasis added). For at least the foregoing reason, claim 30 is allowable over *Takeuchi*, as are claims 31-32 and 38-39 that depend from claim 30.

### III. Claim Rejections - 35 U.S.C. § 103(a)

In the Office Action, claims 2-4, 12, 14, and 33-35 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Takeuchi* in view of *Guerrero* (U.S. Patent No. 6,549,749). Claims 15-16 and 36-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Takeuchi* in view of *Kawahira* (U.S. Patent No. 6,801,750). Claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Takeuchi* in view of *Dim* (U.S. Patent No. 6,460,843). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5

U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

All of the claimed features of independent claims 1 and 30 are not taught and suggested by *Takeuchi*, as previously discussed. Further, the cited art of *Guerrero*, *Kawahira*, and *Dim* fails to cure the deficiencies of the *Takeuchi* reference in suggesting or teaching all of the claimed features in claims 2-4, 12-16, and 33-37 (which depend from respective independent claims 1 and 30). Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Takeuchi* with the cited art has not been made. Therefore, the rejections of claims 2-4, 12-16, and 33-37 should be withdrawn.


### III. Newly Added Claims 40-41

Newly added claims 40-41 (which depend from respective independent claims 1 and 30) are believed to be allowable over the cited art for at least the reasons the discussed above with regard to independent claims 1 and claim 30. Further, the cited references fail to teach or suggest at least wherein a portion of the printed media remains accessible from outside the auxiliary unit as the printed media is inserted into the slot for finishing, as described in the claims. For at least the foregoing reasons, claims 40 and 41 are allowable.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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